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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,092	11/05/2001	James H. Bucksbee	IR-2860(MT)	9463

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Michael M. Gnibus
Lord Corporation
Legal & Patent Services
Post Office Box 8012
Cary, NC 27512-8012

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

09/992,092

Applicant(s)

BUCKSBEE, JAMES H.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,9-12,15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,9-12,15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because the figure below and to the right of figure 5A lacks a figure number and is not described in the specification in the brief description of drawings section. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 22 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 22 depends from cancelled claim 2. Examiner has interpreted the claim as depending from claim 1 for examining purposes.

3. Claims 1, 4, 6, 9-12, 15, and 17-26 are objected to because of the following informalities: with regard to claim 1 Examiner recommends including a comma at the end of line 29 and at the end of claim 41. The remaining claims are objected to due to their dependency from claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 4, 6, 9-12, 15, and 17-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 1, 25, and 26. The phrase "said load bearing member inner rigid member" first claimed in but not limited to line 20 of claim 1 and the phrase " lacks proper antecedent basis in the claim. A similar issue holds true for the phrase "said rebound member inner rigid member", "said load bearing member outer resilient member" and "said rebound member outer resilient member". Examiner recommend initially including such phrases as --a load bearing member inner rigid member--, etc. to provide proper antecedent basis for the above phrases.

Re: claim 1. The phrase "a seat opening" in line 4 is indefinite. It is unclear to the Examiner whether the "seat opening" refers to the "elliptical seat 44" or "the common opening 45" as described and shown.

Re: claims 1, 25, and 26. The phrase "said contact surface" first claimed but not limited to claim 1 line 35 is indefinite. It is unclear to the Examiner as to which contact surface Applicant is referring to. Also, the phrase "said inner rigid member" first claimed in lines 36-37 in claim 1 is indefinite. It is unclear to the Examiner as to which inner rigid member Applicant is referring to.

The remaining claims are indefinite due to their dependency from claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 6, 11, 12, 15, 17, 22-26 is rejected under 35 U.S.C. 102(b) as being anticipated by DE-1650926 (DE '926).

Re: claims 1, 4, 6, 11, 12, 15, 17, 22, 23, 25, and 26. DE '926 shows in figure 3 a mount comprising a rigid housing, the housing having a hollow barrel with a central axis and a first end and an opposing second end, the hollow barrel shown in the area of element 17 defining a first chamber in which upper element 7b is located proximate the hollow barrel first end, a second chamber in which lower element 7b is located proximate the hollow barrel second end, and a seat opening communicating between the first chamber and the second chamber, the seat opening between the hollow barrel first end and the hollow barrel second end, with the first chamber, the seat opening and the second chamber aligned along the hollow barrel central axis, the first chamber having a first chamber mouth shown at the top of the first chamber and a first chamber seat end shown at the bottom of the first chamber with the first chamber mouth proximate the hollow barrel first end and the first chamber seat end proximate the seat opening, the first chamber having a conically contoured wall inwardly tapered from the first chamber mouth to the first chamber seat end as shown, the second chamber having a second chamber mouth shown at the bottom of the second chamber and a

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second chamber seat end shown at the top of the second chamber with the second chamber mouth proximate the hollow barrel second end and the second chamber seat end proximate the seat opening, the second chamber having a conically contoured wall inwardly tapered from the second chamber mouth to the second chamber seat end as shown, a load bearing member upper 7b,18, the load bearing member having a load bearing mouth end and a load bearing seat end, the load bearing member comprised of a molding bonded outer resilient member upper 7b bonded to an inner rigid member 18, the load bearing member inner rigid member having a support surface proximate the load bearing mouth end and an opposing contact surface proximate the load bearing seat end, the load bearing member inner rigid member 18 having an inwardly directed taper from the support surface to the contact surface as shown, the load bearing member outer resilient member having an unbounded outer surface distal from the inner rigid member, the load bearing member outer resilient member unbonded surface having an inwardly directed taper proximate the load bearing seat end as shown, the load bearing member outer resilient member unbonded outer surface inwardly directed taper and the load bearing member inner rigid member inwardly directed taper, a rebound member lower 7b,19, the rebound member having a rebound mouth end and a rebound seat end, the rebound member comprised of a molding bonded outer resilient member lower 7b bonded to an inner rigid member 19, the rebound member inner rigid member having a support surface proximate the rebound mouth end and an opposing contact surface proximate the rebound seat end, the rebound member inner rigid member having an inwardly directed taper from the support surface to the contact

surface, the rebound member outer resilient member having an unbonded outer surface distal from the inner rigid member, the rebound member outer resilient member unbonded outer surface having an inwardly directed taper proximate the rebound seat end, as shown the rebound member outer resilient member having a resilient portion between the rebound member outer resilient member unbonded outer surface inwardly directed taper and the rebound member inner rigid member inwardly directed taper, and a coupling member 20, the coupling member drawing the load bearing member inner rigid member and the rebound member inner rigid member together along the rigid housing hollow barrel central axis through the rigid housing hollow barrel seat opening wherein the load bearing member inner rigid member contact surface and the rebound member inner rigid member contact surface are in abutment with elements 21 and 22 and the load bearing member outer resilient member inwardly directed taper unbonded outer surface seated against the first chamber inwardly tapered wall, the load bearing member outer resilient member resilient portion precompressed between the load bearing member inner rigid member inwardly directed taper and the first chamber inwardly tapered wall, and the rebound member outer resilient member inwardly directed taper unbonded outer surface seated against the second chamber inwardly tapered wall, the rebound member outer resilient member resilient portion precompressed between the rebound member inner rigid member inwardly directed taper and the second chamber inwardly tapered wall.

Re: claim 24. DE '926 shows in figure 3 the limitation wherein the load bearing member comprises a plurality of alignment members or nut and washer shown above element 18 along the support surface.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 10, 18, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '926.

Re: claims 9 and 10. DE '926 describes the invention substantially as set forth Above, but does not include the specific limitation regarding the material of the resilient members being the same or different. Since Applicant failed to provide an explanation of criticality regarding the resilient materials being the same or different. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the resilient members to have been composed of the same or different material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Re: claim 18. DE '926 describes the invention substantially as set forth Above including the limitation of the housing further comprising a mount base shown on the right side of the housing, but does not include the specific limitation of the housing

being unitary. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the housing of DE '926 to have been formed in a unitary manner since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 US 164 (1893).

Re: claim 19. DE'926 describes the invention substantially as set forth above but does not include the limitation of the mount base specifically being H-shaped. In In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration produced an unexpected result. Since Applicant failed to provide an explanation of criticality associated with the mount base being H-shaped, Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount base of DE '926 to have been H-shaped to provide an alternate functionally equivalent means of attaching the mount to a surrounding structure.

Re: claim 21. DE '926 show in figure 3 the limitation wherein the mount further comprises a plurality of arms or left and right projections shown in the area of element 24, the arms extend between the mount base and the barrel as shown.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '926 in view of US Patent 5174552 to Hodgson et al.

DE '926, as modified, describes the invention substantially as set forth above, but

does not include the limitation of the mount base specifically including at least three attachment flanges .

Hodgson et al. teach in figure 1 the use of a mount base 12 comprising at least three attachment flanges 32.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount base of DE '926, as modified, with at least three attachment flanges, as taught by Hodgson et al., in order to provide a means of more securely attaching the mount base to a surrounding structure.

Response to Arguments

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mmb 10/21/03
mmb
October 21, 2003


10/23/2003
MATTHEW C. GRAHAM
PRIMARY EXAMINER
GROUP 310